

10/016,001T075A/TELNP333US**REMARKS**

Applicants' representative acknowledges that prosecution is re-opened in view of the Reply Brief filed on March 22, 2005. Claims 1-3 and 16-23 are currently pending in the subject application and are presently under consideration. Claims 24 and 25 have been newly added herein to emphasize various novel features of applicants' invention, wherein a *search* query is formulated based on: information relating to a scanned item, in conjunction with the demographic information relating to a user of the bar code scanner. No new matter is introduced.

A typographical error is noted in the Office Action on Page 4, paragraph 2, wherein instead of the reference Barnett *et al.* (US Patent 6,336,099), the Dialog reference is cited.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-3 and 16-23 Under 35 U.S.C. §103(a)

Claims 1-3 and 16-23 stand rejected under 35 U.S.C. §103(a) as being obvious over Hudetz *et al.* (US Patent 5,978,773), in view of Barnett *et al.* (US Patent 6,336,099). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Neither Hudetz *et al.* nor Barnett *et al.*, alone or in combination, teach or suggest applicants' claimed invention, let alone there being any motivation to combine the references as suggested other than *via* employment of applicants' specification as a 20/20 hind-sight based road map to achieve the purported combination.

In order to establish a *prima facie* case of obviousness, the teaching or suggestion to make the claim modification *must be found in the cited art*, not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Furthermore, the mere fact that the reference can be modified does not render the modification obvious unless the cited art also suggests the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

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The subject invention as claimed relates to providing demographic information about the consumer to product manufacturers, by utilizing data packet information transferred to manufacturers as a result of the information *inquiry*, or by utilizing information transferred within the web page *request*. The consumer scans a bar code symbol on a product, and by providing an association table, an *inquiry* is made to the product. Demographic information of the consumer is then supplied to the manufacturer, as a result of such *information inquiry/request*. Such aspects of the claimed invention are not taught by Hudetz *et al.* nor Barnett *et al.*, alone or in combination.

Barnett *et al.* is directed to electronic distribution of product redemption coupons to remote personal computers. A user may view, select sort and print desired coupons from a downloaded package. The user's demographic and coupon selection data are provided back to the online service and to the coupon distributor/issuer for subsequent marketing analysis. When the printed coupons are presented to a retail store, the discount is provided. Moreover, Hudetz *et al.* is directed to a system for using identification codes found on ordinary articles of commerce to access remote computers on a network.

Combining Barnet *et al.* with Hudetz *et al.* as suggested in the Office Action, will result in a system wherein a user *initially provides demographic* information to a coupon service provider, followed by printing out the downloaded coupons for presenting to a system that employs an article's UPC to access remote computers on a network. Such is not supplying demographic information to suppliers as a result of an *information inquiry/request*, as in applicants' claimed invention.

Moreover, the Office Action's motivation to achieve the purported combination is *via* employment of applicants' specification as a 20/20 hind-sight based road map, wherein supplying demographic information to a coupon supplier of Barnet *et al.* is combined with the scanner system of Hudetz *et al.* One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988) - and as explained earlier even if the references are combined, applicants' claimed invention does not result. Accordingly, withdrawal of this rejection is respectfully requested.

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Likewise, newly added claims 24 and 25 relate to a *search query* that is formulated based on: information relating to the scanned item, in conjunction with the demographic information relating to a user of the bar code scanner. As explained earlier, such aspects of the claimed invention are not taught or suggested, by Barnet *et al.* with Hudetz *et al.*, alone or in combination.

II. Rejection of Claim 4 Under 35 U.S.C. §103(a)

Claim 4 stands rejected under 35 U.S.C. §103(a) as being obvious over Hudetz *et al.* and Barnett *et al.* as applied to claim 1 above, and further in view of Kaplan (US Patent 5,963,916). Claim 4 depends from independent claim 1, and Kaplan does not make up for the aforementioned deficiencies of Hudetz *et al.* and Barnett *et al.* with respect to independent claim 1.

Additionally, the Office Action states that: “[...] motivation being to encourage a user to purchase certain desired products from the manufactures thereby increasing marketing sales for the manufacturer.” Accordingly, the rationale proffered to combine the references and/or modify the references is to achieve benefits identified in applicants’ specification, which overcome problems associated with conventional systems/methods. Applicants’ representative respectfully submits that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicants’ specification. Such rationale has been condemned by the CAFC. *See, for example, Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987). It is noted that even if the references are combined, applicants’ claimed invention does not result. Accordingly, withdrawal of this rejection is respectfully requested.

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CONCLUSION

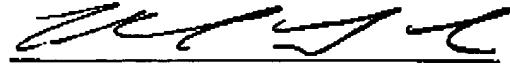
The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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